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HL

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/959,748	10/28/97	CLEMMER	PD-30-3986DI

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HM12/1026

EXAMINER

PRYOR, A

ART UNIT	PAPER NUMBER
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1616

13

DATE MAILED: 10/26/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

2,3 obj  
5-8  
rej  
1,9  
4, 19, 20  
A110

# Office Action Summary

Application No.  
**08/959,748**

Applicant(s)  
**Clemmer et al**

Examiner  
**Alton Pryor**

Group Art Unit  
**1616**



☒ Responsive to communication(s) filed on Feb 10, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-9, 19, and 20 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 1-7, 9, 19, and 20 is/are allowed.

☒ Claim(s) 8 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**Non-Final Action on the Merits**

***Action Summary***

Claims 1-9,19,20 are pending. Claim 8 is rejected. Claims 1-7,9,19,20 are allowable.

**I. Rejections of claims 1-4,6-9 under 35 U.S.C. 102(a,e) will not be maintained in light of amendment filed 2/18/99.** Applicants submitted a Declaration to overcome the rejection.

**II. Double Patenting Rejection will not be maintained in light of amendment filed 2/18/99.** Applicants submitted a Terminal Disclaimer to overcome the rejection.

**III. Claim Objection will not be maintained in light of amendment filed 2/18/99.**

**Applicants have provided a Declaration to overcome rejection of claim 5.** Applicants are correct in that Examiner made an error in his objection of claim 20.

**IV. Applicant's arguments with respect to claim 8 have been considered but are moot in view of the new ground(s) of rejection.**

***Claim Rejections under 35 U.S.C. 112, 1st paragraph***

Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In claim 8 applicants claim oxyfluoride as a catalyst. However, in the specification oxyhalides are disclosed as catalysts. Although oxyfluoride is a species in the oxyhalide genus, how would one having ordinary skill in the art know, based on the applicants' specification, that oxyfluoride is the

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preferred or best oxyhalide to use in instant process. In re Ruschig 154 USPQ 118, CCPA 1967.

Also, in claim 8, applicants claim Zn as a catalyst. Zn is not describe in the specification as a catalyst. However, Zn compounds (zinc oxides) and Zn complexes (e.g. Zn on Al or Mg) are disclosed in the instant specification.

**V. Examiner acknowledges applicants' request for an interference.** The examiner will subject instant application into interference status once the above matters are clarified or corrected.

*Telephonic Inquiry*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton Pryor whose telephone number is (703) 308-4691. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees, can be reached on (703) 308-4628. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

ANP

10/22/99



S. MARK CLARDY  
PATENT EXAMINER  
GROUP 1200-1616

Acting SRE